

Notice of Allowability

Application No.

10/669,492

Applicant(s)

FARNHAM ET AL.

Examiner

Sin J. Lee

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/23/05.
2. ☒ The allowed claim(s) is/are 1-4,6-14,16-24 and 27-33.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>8-29-05</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

EXAMINER'S AMENDMENT

1. Applicants canceled claims 5, 15, 25 and 26.
2. In view of the amendment of May 23, 2005, previous 103(a) rejection on claims 1-4, 6, 9-12 and 24 over Nishimura et al'414 is hereby withdrawn. Nishimura does not teach or suggest present hydroxyl ester functional group of the formula $-\text{CO}_2-\text{C}(\text{Me})_2-\text{C}(\text{Me})_2-\text{OH}$ of claims 1, 6 and 24.
3. In view of the amendment of May 23, 2005, previous 103(a) rejection on claims 1, 6, 7, 9, 14 and 18-26 over Sato et al'458 is hereby withdrawn. Sato does not teach or suggest present hydroxyl ester functional group of the formula $-\text{CO}_2-\text{C}(\text{Me})_2-\text{C}(\text{Me})_2-\text{OH}$ of claims 1, 6 and 24. Also, Sato does not teach or suggest present repeat unit (c) of claim 14 nor present repeat unit (iii) of claim 18.
4. In view of the amendment of May 23, 2005, previous 103(a) rejection on claims 1, 6-8 and 11 over Yabuuchi'267 is hereby withdrawn. Yabuuchi does not teach or suggest present hydroxyl ester functional group of the formula $-\text{CO}_2-\text{C}(\text{Me})_2-\text{C}(\text{Me})_2-\text{OH}$ of claims 1 and 6.
5. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.
6. Authorization for this examiner's amendment was given in a telephone interview with Ms. Karin J. Karel (attorney for applicants) on August 29, 2005.
7. The application has been amended as follows:

In Claim 27, on the fourth line from the bottom of the claim, after "compound" and before "; and", insert --- wherein the ethylenically unsaturated group is contained within the polycyclic moiety ---.

In Claim 28, on the sixth line from the bottom of the claim, after "compound" and before "; and", insert --- wherein the ethylenically unsaturated group is contained within the polycyclic moiety ---.

In Claim 33, on the twentieth line from the beginning, after "compound" and before "is", insert --- which ---.

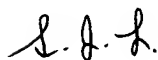
8. The following is an examiner's statement of reasons for allowance: As indicated above, none of the cited prior arts teaches or suggests present hydroxyl ester functional group of the formula $-\text{CO}_2-\text{C}(\text{Me})_2-\text{C}(\text{Me})_2-\text{OH}$ of claims 1, 6 and 24. As indicated above, Sato'458 does not teach or suggest present repeat unit (c) of claim 14 nor present repeat unit (iii) of claim 18. Also, Sato'458 does not teach or suggest present second repeat unit of claims 27 and 28, which is derived from a polycyclic ethylenically unsaturated compound *wherein the ethylenic unsaturation is contained within the polycyclic moiety (as amended above)*. As previously indicated, none of the cited prior arts teaches or suggests present repeat unit of claims 29 and 30, which is derived from NB-F-OH. None of the cited prior arts teaches or suggests present repeat unit (b) of claim 33.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

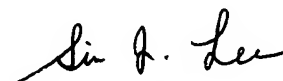
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Lee
August 29, 2005


SIN LEE
PRIMARY EXAMINER